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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,764	12/13/2005	Carl-Johan Aurell	ASZD-P01-111	7402

52286 7590 02/16/2007
COZEN O'CONNOR, P.C.
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PHILADELPHIA, PA 19380

EXAMINER

NAGUBANDI, LALITHA

ART UNIT	PAPER NUMBER
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1621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.		Applicant(s)	
	10/560,764		AURELL ET AL.	
	Examiner		Art Unit	
	Lalitha Nagubandi		1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/13/2005</u> | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Status of Claims

Claims 1-8 are currently pending. Claims 1-8 are considered for examination in this office Action.

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Priority

This application is a 371 of PCT/SE04/00966 dated June 16th, 2004, which claims priority to United Kingdom application no. 0314134.8 dated June 18th, 2003.

Information Disclosure Statement

Receipt of the information Disclosure Statement filed on 12/13/2005 is acknowledged and has been considered and made of record.

Claim Rejections - 35 USC § 102

Claims 1-8 rejected under 35 U.S.C. 102(e) as being anticipated by Lindstedt et al (WO 03/051821 A1 dated 26th June 2003, international filing date: 18th December 2002).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the

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reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) that forms the basis for all obviousness rejections set forth in this Office action:

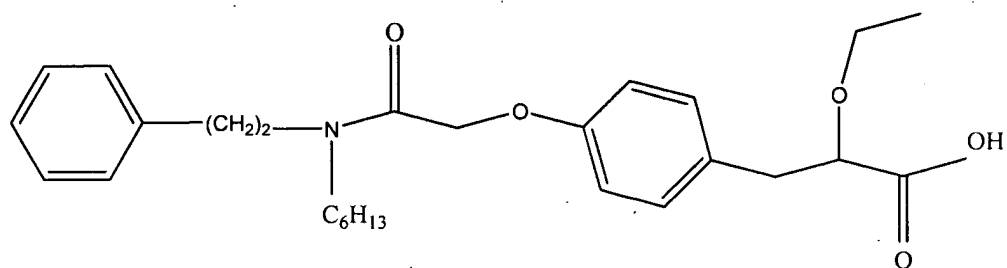
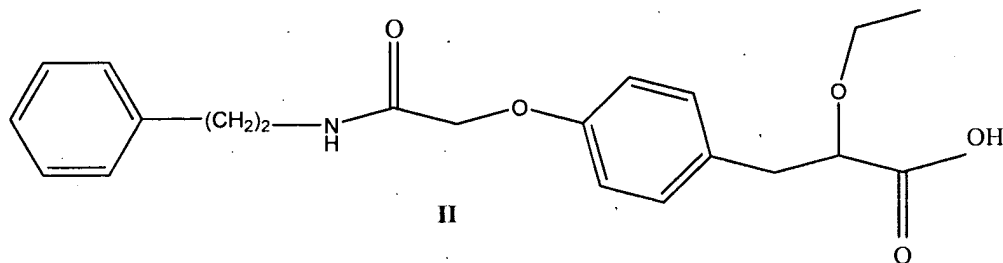
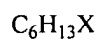
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2 and 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindstedt et al (WO 03/051821 A1), and Mijin et al (Russian Journal of Organic Chemistry Vol. 34 No. 10, 1998).

Applicants claim a process for the preparation of a compound of formula I in which a compound of formula II is reacted with a compound of formula III.

**I****II****III****Determination of Scope and content of the Prior Art (MPEP§2141.01)**

Lindstedt et al teach (See page 4 lines 15-25 and page 5-15) a process for the Preparation of compound of **formula I** by reacting the S-enantiomer of a compound of **formula III** with a compound of **formula IV** in presence of a coupling agent under basic conditions, at a temperature in the range of $-25^{\circ}C$ to $150^{\circ}C$.

Mijin et al teach the alkylation processes of N-substituted amides under phase-transfer conditions. (see page 1513. **Scheme I**, Russian Journal of Organic Chemistry Vol. 34 No. 10, 1998).

Ascertainment of the difference between the Prior Art and Claims (MPEP §2141.02)

The difference between the instant method and Lindstedt et al is that the instant process requires alkylation of the N-substituted amides. It is understood that initial process involved the coupling reaction, which is followed by the N-alkylation.

Lindstedt et al teach (See page 4 lines 15-25 and page 5-15) the process of coupling reaction and it is understood that an N-alkylation is carried out prior to the coupling step.

Mijin teaches a general method of N-alkylation of N-substituted amides under phase transfer conditions.

As far as the product of the instant application and the prior art are concerned, the difference is at the N-substitution.

Finding of prima facie obviousness – rational and motivation (MPEP § 142-2143)

Accordingly, one of ordinary skill in the art would be motivated to prepare the instant products by manipulating process parameters, and reversing the synthetic process steps like in the instant case where, coupling reaction is performed as the initial step followed by the N-alkylation, which may be necessary as cost effective measure.

Therefore the subject matter as a whole would have been obvious to one of ordinary skill in the art and one would have been motivated to combine and modify the methods cited above at the time of invention, and the ordinary artisan would have had a reasonable expectation of success and hence it is a prima facie obvious.

Conclusion

No claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalitha Nagubandi whose telephone number is 571 272 7996. The examiner can normally be reached on 6.30am to 3.00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 571 272 0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

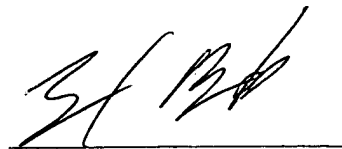
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lalitha Nagubandi

Patent Examiner

Technology Center 1600

February 13th, 2007



Samuel A Barts

Primary Patent Examiner

Technology Center 1600